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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,138	12/29/2000	Dale W. Malik	BS00-170	6782

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EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/750,138	MALIK, DALE W.	
	Examiner	Art Unit	
	George C. Neurauter, Jr.	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-8,15 and 21-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-8,15 and 21-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claims 1-3, 6-8, 15, and 21-45 are currently presented and have been examined.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 18 July 2006 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-3, 6-8, 15, and 21-45 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 30-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites "wherein the step of checking is performed when the electronic mail message is performed periodically on the host computer". This limitation has grammatical errors and it is not clear what is specifically being recited, specifically what is performed on the electronic mail message in order to trigger the step of checking.

Claims 30-33 recite "...the screening..." The step of "screening" has insufficient antecedent basis in the claims.

In order to avoid piecemeal examination and to give the Applicant a better appreciation for relevant prior art, the Examiner will assume that the step of screening is the previously recited step of checking. See, e.g., *Ex parte Ionescu*, 222 USPQ 537 (Bd. App. 1984) and MPEP 2173.06.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the

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United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-8, 15, and 21-45 are rejected under 35

U.S.C. 102(e) as being anticipated by US Patent 6 842 768 B1 to Shaffer et al.

Regarding claim 1, Shaffer discloses a method for automatically managing an electronic mail server application on a host computer, comprising the steps of:

checking an electronic mail message against a predetermined criteria; determining whether the message has been previously compressed; compacting ("compressing") a non-attachment portion (referred to within the reference as "message") of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and storing the compacted electronic mail message. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account..."; column 6, lines, 65-67, "The figure shows a representation of multimedia email system 210 with individual original messages 252 and !compressed (sp) messages 254.")

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Regarding claim 2, Shaffer discloses the method of claim 1, wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application. (column 3, lines 25-29, "Device 130 represents any type of device or system or network that provides data to user information appliances, such as, but not limited to...an email server..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account...") (Examiner's note: Note that it is inherent within the reference that email servers receive and store messages for clients before the clients access their email account).

Regarding claim 3, Shaffer discloses the method of claim 1, wherein the step of checking is performed when the electronic mail message is performed periodically on the host computer. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account or the file may be

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compressed on-the-fly as a user logs in or as a user requests download of a particular message")

Regarding claim 6, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises a total message size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a message..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 7, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises an attachment size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 8, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises an attachment type. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically

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"...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission."; column 8, lines 7-10, "Other parameters according to the invention may indicate what decoding formats can be handled by the client and therefore allow a server to determine desired compression formats.")

Regarding claim 15, Shaffer discloses the method of claim 1, further comprising the step of compressing the attachment. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 21, Shaffer discloses a method for managing a user's electronic mailbox on a computer, comprising the steps of performing an off-peak hours routine (column 8, lines 30-34, "An intelligent component of the system might also defer performing any pre-compression while the computer system is experiencing heavy use or might defer pre-compression") for checking an electronic mail message against a predetermined criteria; compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein

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the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns (column 8, lines 45-56); and storing the compressed electronic mail message. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account..."; column 6, lines, 65-67, "The figure shows a representation of multimedia email system 210 with individual original messages 252 and !compressed (sp) messages 254.")

Regarding claim 22, Shaffer discloses the method of claim 21, wherein the step of checking is performed when the electronic mail message is received by the electronic mailbox. (column 3, lines 25-29, "Device 130 represents any type of device or system or network that provides data to user information appliances, such as, but not limited to...an email server..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email

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account...") (Examiner's note: Note that it is inherent within the reference that email servers receive and store messages for clients in their respective accounts or "mailboxes" before the clients access their email account).

Regarding claim 23, Shaffer discloses the method of claim 21, wherein the step of checking is performed upon request by the user. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file...or the file may be compressed on-the-fly as a user log ins or as a user requests download of a particular message.")

Regarding claim 26, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises a total message size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a message..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 27, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises an attachment size. (column 2, lines 39-48, specifically "...the size of the

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data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 28, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises an attachment type. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission."; column 8, lines 7-10, "Other parameters according to the invention may indicate what decoding formats can be handled by the client and therefore allow a server to determine desired compression formats.")

Regarding claims 30-32, Shaffer discloses the method of claim 21, wherein the location of the screening of the message is on a server, a client, or configured by a user. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a message... In specific embodiments, a user may indicate (either at the time of transfer, the time of login, or during client setup) an

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acceptable delay or desired compression for a transfer.";column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 33, Shaffer discloses the method of claim 21, wherein the screening is performed periodically on the computer. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account or the file may be compressed on-the-fly as a user logs in or as a user requests download of a particular message")

Regarding claim 34, Shaffer discloses the method of claim 21, wherein the electronic mail message is compressed into a zipped file. (column 8, lines 45-56, specifically "It should be understood that a data file or a message may be encoded into a variety of compression formats. Some of these formats, such as ...ZIP...have built-in variable compression.")

Claims 35-42 are also rejected since these claims recite a computer readable medium that contain substantially the same limitations as recited in claims 21-23, 33, 26-28, and 34 respectively.

Regarding claim 43, Shaffer discloses the method of claim 1, further comprising decompacting the compacted electronic mail message for retrieval. (column 5, lines 30-44, specifically "Optionally, there may also be a selectable option that a user can use to indicate that the system should download a compressed file or original file according to default rules. Selection by a user is registered by the client-side logic (Step B3) and is communicated so that the appropriate file format may be transmitted (Step B4)."; column 8, lines 35-45, specifically "The server maintains information about which algorithms are available at a particular client and may learn from the client from time to time which algorithms are available at the client or desired by the user such as via a compression format list 250. According to a further embodiment, a server can in some instances download to the client an application or applet 240 to enable the client to handle a particular type of compressed file")

Claims 44 and 45 are also rejected since these claims recite a method and computer readable medium that contains substantially the same limitations as recited in claim 43.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is (571) 272-3918. The examiner can normally be reached on Monday through Friday from 9AM to 5:30PM Eastern.

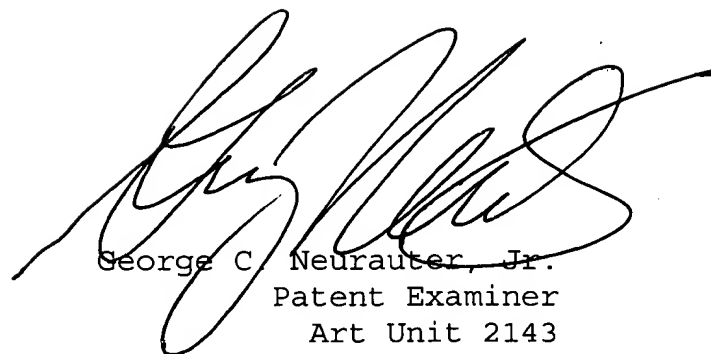
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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George C. Neurauter, Jr.
Patent Examiner
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